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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,889	12/14/2001	Martin D. Nathanson	13407.00010	2385

27160 7590 10/31/2005

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EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT PAPER NUMBER

2152

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/014,889	NATHANSON, MARTIN D.	
	Examiner	Art Unit	
	Victor Lesniewski	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/22/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 8/9/2005 has been placed of record in the file.
2. No claims have been amended.
3. Claims 1-20 are now pending.
4. The declaration filed on 8/9/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Lang et al. (U.S. Patent Number 6,295,492) reference. Thus, claims 1-20 remain rejected as presented in the previous action dated 2/9/2005.

Response to Declaration

5. The declaration filed on 8/9/2005 is ineffective because the evidence submitted is insufficient to establish conception and is insufficient to establish diligence as discussed below.
6. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Lang et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).
7. The applicant is required to give a clear explanation of the exhibits pointing out exactly what facts are established and relied on. See MPEP 715.07. In the present declaration, the applicant refers to "Exhibit A" but it is unclear exactly what Exhibit A is. Each document submitted as evidence should be discussed so that each document's relation to the conception of the invention is clearly set forth. It is recommended that the applicant separately label each

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document as an exhibit, or group similar documents together as an exhibit. Then each exhibit should be separately discussed with reference to the conception of the invention.

8. Further, the declaration states that Exhibit A describes the invention as claimed, but the declaration does not describe where in the exhibit the recited limitations are found. It is recommended that in discussing each exhibit in terms of conception the applicant provide some mapping or direction as to where in the exhibit the claimed limitations are found. Currently, the claim limitations cannot be clearly identified in Exhibit A and thus conception cannot be established.

9. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Lang et al. reference to the constructive reduction to practice. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that the applicant or patent owner had been diligent. Rather, the applicant must show evidence of facts establishing diligence. See MPEP 715.07(a).

10. Here, it is noted that neither the present declaration nor the supporting documents contain any dates that would allow for the establishment of diligence. It is impossible to ascertain from Exhibit A an establishment of diligence since the exhibit does not set forth what pieces of the evidence the applicant was developing at what times. From the facts as shown, it is impossible to construct a timeline from conception to constructive reduction to practice that shows whether or not the applicant was diligent at a given time or times on the timeline.

Conclusion

11. **THIS ACTION IS MADE FINAL.** The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.

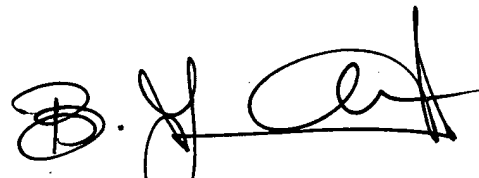
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor Lesniewski
Patent Examiner
Group Art Unit 2152



BUNJOR JAROENCHONWANIT
PRIMARY EXAMINER